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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,843

12/31/2003

Anil Chatterji

C261 1060.1

2822

26158

7590

04/10/2007

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

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ATLANTA, GA 30357-0037

EXAMINER

CARTER, KENDRA D

ART UNIT

PAPER NUMBER

1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

04/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/748,843

Applicant(s)

CHATTERJI ET AL.

Examiner

Kendra D. Carter

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1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-42, in part, are drawn to a method for modulation of immune response by differentiation of dendritic cells comprising administering a compound having the general formula $Z-OC(CR_{n1}R_{n2})-CO-Z$, wherein $Z = OH$ classified in class 514, subclasses 785 and 885.
- II. Claims 1-42, in part, are drawn to a method for modulation of immune response by differentiation of dendritic cells comprising administering a compound having the general formula $Z-OC(CR_{n1}R_{n2})-CO-Z$, wherein $Z = NH_2$ classified in class 514, subclasses 784 and 613.
- III. 1-42, in part, are drawn to a method for modulation of immune response by differentiation of dendritic cells comprising administering a compound having the general formula $Z-OC(CR_{n1}R_{n2})-CO-Z$, wherein $Z = OH$ and NH_2 classified in class 514, subclasses 784, 613, and 885.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I to Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

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designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of Group I to Group III does not have the same compounds. For example, the compounds of Group I are carboxylic acids, the compounds of Group II are amides, and the compounds of Group III possess both a carboxylic group and an amide group. The differences in structural features will result in different reactivity, solubility, oral bioavailability, etc. Thus, by virtue of the different structures and reactivity of these compounds, the efficacy will inherently be different.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper. It is noted that while the searches of Groups I to Group III may be overlapping, there is no reason to believe that the searches would be coextensive. For example, in searching Group I, Examiner will be focusing on the patentability of the method comprising the compounds of group I itself, and not the administration of the compounds of Group II. Conversely, in searching Group II, Examiner will be focusing on the patentability of the method comprising administering the compounds of Group II and not the compounds administered in Group I.

This application contains claims directed to the following patentably distinct species:

- 1) the compound having general formula $Z-OC(CR_{n1}R_{n2})-CO-Z$,
- 2) structure 1;
- 3) structure 2; and

4) structure 3.

The species are independent or distinct because they are different structures classified in different classes and subclasses. The differences in structural features will result in different reactivity, solubility, oral bioavailability, etc. Thus, by virtue of the different structures and reactivity of these compounds, the efficacy will inherently be different.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

No phone call was made due to the complexity of the restriction requirement.

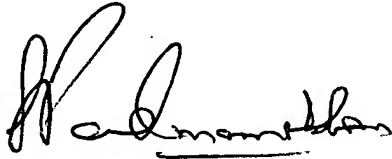
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kendra D. Carter whose telephone number is (571) 272-9034. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDC



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER